

REMARKS

Applicant would like to thank the Examiner for taking time on December 10, 2007, to discuss the outstanding Final Office Action. Reconsideration of the rejection set forth in the Office Action dated October 30, 2007, is respectfully requested. Claim 12 has been amended to require (1) inserting no more than one implant through an elongate tubular member, (2) the appendages be joined to form an interior angle and an exterior angle, the interior angle being smaller than the exterior angle during insertion through the elongate tubular member, and (3) the interior angle between appendages is larger after deployment than during the step of inserting the implant into the defect. These amendments are a simple recitation of geometric properties depicted in Figures 13 and 14 and the differences between these properties in the transformation from a pre-deployment to post-deployment condition as described at page 13 of the original specification. Therefore, these amendments are made without introducing new matter.

Claims 12, 13, and 16-18 were rejected under 35 U.S.C. § 102 for alleged anticipation by Baumgartner. These rejections should be withdrawn for the following reasons.

Claim 12 is limited to the step of “inserting no more than one implant into the defect in the annulus fibrosis.” Baumgartner requires multiple implants for the design and methods adopted in Figs. 1-5 of Baumgartner. During a discussion on December 10, 2007, the Examiner questioned whether Baumgartner’s device 7 shown in Figs. 4(e) and 5 could be considered the “implant” of claim 12. It cannot because Baumgartner plainly teaches the use of device 7 in combination with numerous separately insertable support members 7 as shown in Figs. 1, 2, 3 and 3(a). See 1:45-48 (“This object is achieved in accordance with the invention in that the implant contains at least three elastically deformable support members which can be inserted into

the central cavity and can be positioned therein.”)(emphasis added) and 3:47-52 (“An intervertebral prosthesis in the form of an implant consisting of several support members 7, which can be inserted one after the other into the cavity 5, and which are made from an elastic plastic well tolerated by the body, e.g., polyurethane, is provided as a replacement for at least one part of the core region removed.” (emphasis added)) Thus, Baumgartner’s Figs. 1-5 require numerous implants and therefore do not describe, and actually teach away from the step of “inserting no more than one implant.”

The office action asserts, however, that “single-piece chains” as depicted in Figs. 6-8 involve the use of no more than one implant. Claim 12 now requires the at least two appendages to be joined to form an interior angle and an exterior angle, wherein the interior angle is “smaller than the exterior angle during insertion through the elongate tubular member” and “the interior angle is larger after deployment than during the step of inserting the implant.” First, applicants assert it is erroneous to arbitrarily select one of support members 7 in the chain and then designate as “appendages” all structures to the left and right of the selected support member. In any case, adopting that interpretation, the interior angle between “appendages” during deployment of Baumgartner’s devices shown in Figs. 6-8 is always 180° because the implant passes through a linear tube during the step of inserting. Thus, in Baumgartner the interior angle is not smaller than the exterior angle during insertion through the elongate tubular member.

After deployment in the cavity, the implant is tightly packed and the “appendages” will bend to form an interior angle of less than 180°. See 2:18-23 (“Several support members can be connected in chains to form a string-like, flexible support, whereby the distance between two support members advantageously corresponds at least to the diameter of one of the support

members, in order to enable deviations of 180° when inserting the support members.”); 5:49-57 (“[t]he support members 7 are sequentially inserted into a central cavity 5 constructed in the core region by means of a tube 6 passing through an outer annular region 4 of the intervertebral disk 3, until said cavity is substantially filled. When the cavity 5 is clogged with the filling members 7, they become deposited at the boundary walls of the annular region 4 and against one another and are elastically deformed under stress.” (emphasis added)). Thus, the interior angle after deployment will necessarily be 180° or less because any bending whatsoever will reduce the angle below 180°. Baumgartner therefore teaches away from the claimed requirements that (1) the interior angle between appendages is smaller than the exterior angle during insertion through the elongate tubular member, and (2) the interior angle between appendages be larger after deployment.

Claim 12 is therefore patentably distinct from the cited references. Each of claims 13 and 16-18 are dependent on claim 12 and therefore are patentably distinct from the cited references for the same reasons applicable to claim 12. The rejections under §§ 102 and 103 should therefore be withdrawn.

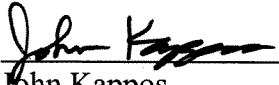
For all the foregoing reasons, Applicant asserts the claims are in condition for allowance. Favorable action on the merits of the claims is therefore earnestly solicited. If any issues remain, please contact Applicant’s undersigned representative at (949) 760-9600. The Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account No. 50-2862.

Patent
Attorney Docket: 026,314-018
(Formerly BAF-12802/29)

Respectfully submitted,

O'MELVENY & MYERS LLP

Dated: December 17, 2007

By: 
John Kappos
Reg. No. 37,861

610 Newport Center Drive, 17th Floor
Newport Beach, CA 92660-6429
(949) 760-9600